

REMARKS

The present application was filed on December 28, 2001 with claims 1-49. Claims 1-7, 11, 12, 17-20, 28, 31, 32, 34, 41, 46, and 48 remain pending and claims 1, 34, 41, 46, and 48 are the pending independent claims. Claims 8-10, 13-16, 21-27, 29-30, 33, 35-40, 42-45, 47, and 49 have been canceled without prejudice.

In the final Office Action dated November 26, 2007, the Examiner: (i) rejected claims 1-5, 12, 17, 28, and 34 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,931,908 to Gerba et al. (hereinafter "Gerba") in view of U.S. Patent Publication No. 2005/0132295 to Noll et al. (hereinafter "Noll"), and further in view of U.S. Patent Publication No. 2005/0015796 to Bruckner et al. (hereinafter "Bruckner"); (ii) rejected claim 6 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Noll and Bruckner, and further in view of U.S. Patent Publication No. 2005/0273828 to Barton (hereinafter "Barton"); (iii) rejected claims 7 and 32 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Noll and Bruckner, and further in view of U.S. Patent No. 6,944,228 to Dakss et al. (hereinafter "Dakss"); (iv) rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Noll and Bruckner, and further in view of U.S. Patent No. 6,711,552 (hereinafter "Kay"); (v) rejected claim 18 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Noll and Bruckner, and further in view of U.S. Patent No. 6,421,726 to Kenner et al. (hereinafter "Kenner"); (vi) rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Noll and Bruckner, and further in view of U.S. Patent Publication No. 2002/0016965 to Tomsen et al. (hereinafter "Tomsen"); (vii) rejected claims 20 and 31 under 35 U.S.C. §103(a) as being unpatentable over Gerba in view of Noll and Bruckner, and further in view of U.S. Patent No. 5,878,141 to Daly et al. (hereinafter "Daly"); (viii) rejected claim 41 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2004/0015986 to Carver et al. (hereinafter "Carver") in view of Noll, and further in view of Bruckner; and (ix) rejected claims 46 and 48 under 35 U.S.C. §103(a) as being unpatentable over Tomsen in view of Noll, and further in view of Bruckner. Applicants respectfully request reconsideration of the present application in view of the remarks below.

In response to the Examiner's various §103 rejections, Applicants have amended independent claims 1, 34, 41, 46, and 48 without prejudice and solely to clarify the subject matter in which the

inventors claim as their invention. Independent claims 1, 34, 41, 46, and 48 now recite “further wherein the non-interactive advertising content is not originally created for interactivity.” Support for this amendment can be found in the specification at page 12, lines 21-22.

Independent claim 1 now recites an apparatus for controlling interactive television offerings over a transaction-enabled broadcast network, the apparatus comprising at least one central system processor of a multi-service operator. The processor is operative to: (i) receive broadcast content from a broadcast content source; (ii) process the broadcast content; (iii) transmit said processed broadcast content over said network to a viewer; (iv) receive request data over said network from said viewer, said data being transmitted by said viewer in response to said processed broadcast content; and (v) process said request data. The at least one central system processor of a multi-service operator is further operative as a central point of control for said request data or interactive content contained within said broadcast content. The at least one central system processor collects information about viewer transactions for commerce purposes. The at least one central system processor is further operative to add interactive advertising content to non-interactive advertising content for a period of time defined by at least one local merchant offer, wherein the non-interactive advertising content is not originally created for interactivity. The at least one central system processor is further operative to route the request data to the at least one local merchant using at least one advertisement identifier. The apparatus further comprising memory, operatively coupled to the central system processor of a multi-service operator, for storing at least a portion of data related to at least one of the receiving, transmitting and processing steps. Independent claims 34, 41, 46, and 48 recite subject matter similar to claim 1.

In an illustrative embodiment of the invention, FIG. 2 shows one possible embodiment of the basic steps performed by a controller of the invention. In step 202, broadcast content is received from a broadcast content source. In step 204, the broadcast content is processed. In step 206, the processed broadcast is transmitted over the network to a viewer. In step 208, the controller receives request data from a viewer. The request data is transmitted by the viewer in response to receiving the processed broadcast content. In step 210, the request data from the viewer is processed by the controller 100.

In an additional illustrative embodiment, FIG. 1 shows a controller 100 in accordance with the present invention. In processing broadcast content, the controller can, for example, manage, add to, or modify the broadcast content. For example, the controller can add interactive content to an advertisement that was not originally an interactive ad. The processor can also redirect network traffic to the appropriate server for local fulfillment of goods and services which are advertised in broadcast ads, and which are purchased through interactivity with those ads. In processing data received from the viewer, the controller can, for example, tabulate purchasing history information, store credit card and ship-to information of the viewer, and verify the identification of the viewer. The controller can also be operatively configured to tabulate commerce transactions occurring over the network.

Further, ads or programs which are not originally created for interactivity (i.e. simple video/audio content) are made interactive by the controller 100. An authoring toolset such as IBM HotMediaTV™ can be used to enrich the video/audio content of the program or advertisement, to add interactive data to it. Clearly, the advertiser or program sponsor must agree to have their content enhanced in this way, and business methods are provided herein to cover this situation. The advertiser would contract with the network operator to have their ads enhanced with interactive content for a given time period. One advantage to this method versus creating a fixed-content interactive ad is that the added content can change over time. For example, an advertiser who is running a limited time sale can have the interactive content reflect this time limit, and then go back to airing the basic interactive content when the sale has expired. The controller 100 would receive the unenhanced ad from the content provider or advertiser and inject data into the broadcast stream at the time the ad was scheduled.

In addition, based on business agreements, the controller 100 can route user transactions. “Redirect URLs” are specified and stored in the controller 100 in order to map the URL from the broadcast ad to the appropriate local server. When the user interacts with the advertisement, typically by pressing a key on the remote control and using the telephone line for a return channel, the controller 100 recognizes the advertisement by use of a unique ad identifier and maps it to a local server.

Applicants note that a proper case of obviousness has not been presented if the references, when combined, do not teach or suggest all the claim limitations. Furthermore, the claimed subject matter is not obvious if there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to modify the reference teachings. An analysis supporting a rejection under 35 U.S.C. §103 should be explicit and should not be based on mere conclusory statements. See KSR v. Teleflex, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (U.S., Apr. 30, 2007), quoting In re Kahn, 441 F. 3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”).

With regard to the §103(a) rejection of claims 1-5, 12, 17, 28, and 34 over Gerba in view of Noll, and further in view of Bruckner, Applicants respectfully submit that the combined references fail to teach or suggest all the limitations of the recited claims, as amended. First, Applicants submit that Gerba fails to teach a central system processor of a multi-service operator that can control interactive television offerings over a transaction-enabled broadcast network as recited in independent claims 1 and 34. More specifically, Gerba does not teach a central system processor of a multi-service operator as a central point of control for the request data or interactive content contained within the broadcast content. The Examiner cites that Gerba discloses a central system processor (e.g., processing unit) at Figure 1, block 12. See Final Office Action, page 4, first partial paragraph. The Examiner then argues that Gerba teaches a central system processor that is further operative as a central point of control for the request data or interactive content contained within the broadcast content. Id. To support this argument, the Examiner cites Gerba, Figure 1, block 12, and col. 9, lines 11-27. Id. Applicants respectfully note that Gerba, col. 9, lines 11-27 discloses the function of a “transaction processor.” The transaction processor is found at Gerba, Figure 1, block 24, which is a processor separate and distinct from the processing unit (Gerba, Figure 1, block 12; and Figure 4 (illustrating the distinct process performed by the processing unit)). Applicants assert that Gerba discloses a head-end system with multiple processors, which carry out different functions. Therefore, Gerba does not teach a central system processor of a multi-service operator that is a central point of control for request data or interactive content contained within the broadcast content,

as recited in the claims. Further, the other cited references fail to remedy the deficient teachings of Gerba.

Next, the Examiner concedes that Gerba is silent on a central system processor that collects information about viewer transactions for commerce purposes and that the central system processor is further operative to add interactive advertising content to non-interactive advertising content for a period of time defined by at least one local merchant offer; wherein the at least one central system processor is further operative to route the request data to the at least one local merchant using at least one advertisement identifier. See Final Office Action, page 4, last paragraph; and page 7, first partial paragraph. Applicants submit that neither Noll nor Bruckner remedy the deficiencies of Gerba with respect to these limitations.

The Examiner first argues that Noll teaches an apparatus for controlling interactive television offerings over a transaction enabled broadcast with a central system processor that collects information about viewer transactions for commerce purposes. See Final Office Action, page 5, first paragraph. Applicants respectfully disagree. Noll teaches delivering content using virtual channels. Therefore, Noll discloses techniques which are only applicable to the internet. It follows that, Noll fails to teach the limitation of a central system processor that collects information about viewer transactions for commerce purposes as recited in the claims.

The Examiner also argues that Bruckner discloses the at least one central system processor that is further operative to add interactive advertising content to non-interactive advertising content for a period of time defined by at least one local merchant offer. Id. Applicants respectfully submit that Bruckner fails to teach adding interactive advertising content to non-interactive advertising content as recited in the claims. Bruckner discloses triggers which signal the displaying of interactive commercial content. See, Bruckner, page 5, para. 50. Bruckner discloses that “A commercial break may contain both regular, non-interactive commercials and interactive commercials. Interactive commercials contain triggers for retrieving the interactive commercial content.” Id. Therefore, Applicants contend that Bruckner is not adding interactive advertising content to non-interactive advertising content, rather Bruckner discloses interactive commercials containing triggers which are used to signal the retrieval of interactive commercial content. Id. Nonetheless, Applicants have respectfully amended the claims to specify that the non-interactive

advertising content is not originally created for interactivity, unlike Bruckner, to further distinguish the claimed subject matter.

The Examiner further argues that Bruckner teaches that the at least one central system processor is further operative to route the request data to the at least one local merchant using at least one advertisement identifier. See Final Office Action, page 5, first paragraph. Applicants assert that Bruckner is disclosing the retrieval of interactive commercial content from a remote website. See Bruckner, page 5, paras. 54-58. Bruckner is not disclosing a central system processor that routes request data from a viewer to the at least one local merchant using at least one advertisement identifier as recited in the claims.

For at least these reasons, Gerba, Noll, and Bruckner fail to teach the limitations of independent claims 1 and 34.

Applicants further submit that there is no motivation or suggestion to combine or modify the cited references. The Examiner states on page 5, last paragraph, to page 6, first partial paragraph; and page 8 of the final Office Action:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerba to include network operations center (NOC) or local processor collects information about viewer transactions for commerce purposes as taught by Noll for the benefit of targeting advertising and e-commerce material to the user and for determining account balances and transactional information as disclosed by Noll. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include the central system processor is further operative to add interactive advertising content to non-interactive advertising content for a period of time defined by at least one local merchant offer; wherein the at least one central system processor is further operative to route the request data to the at least one local merchant using at least one advertisement identifier as taught by Bruckner in order to manage interactive content that may or may not be known in advance and to be able to sell advertising space to the highest bidder as disclosed by Bruckner.

Applicants respectfully submit that this is a conclusory statement of the sort rejected by both the Federal Circuit and the U.S. Supreme Court. See KSR v. Teleflex, No. 13-1450, slip. op. at 14 (U.S., Apr. 30, 2007), quoting In re Kahn, 441 F. 3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness.”). There has been no showing in the present §103(a) rejection of the claims of objective evidence of record that would motivate one skilled in the art to combine Gerba, Noll, and Bruckner to produce the particular limitations in question.

For at least these reasons, Applicants assert that the cited references fail to render claims 1 and 34 unpatentable. It follows that the cited references fail to render dependent claims 2-5, 12, 17, and 28 unpatentable due to their dependency from independent claim 1. Therefore, Applicants respectfully request withdrawal of the §103(a) rejection.

With regard to the §103(a) rejection of claim 41 over Carver in view of Noll, and further in view of Bruckner, Applicants respectfully submit that the combined references fail to teach or suggest all the limitations of claim 41, as amended. The Examiner concedes that Carver is silent on a central system controller that collects information about viewer transactions for commerce purposes and that the central system processor is further operative to add interactive advertising content to non-interactive advertising content for a period of time defined by at least one local merchant offer; wherein the at least one central system processor is further operative to route the request data to the at least one local merchant using at least one advertisement identifier. See Final Office Action, pages 18-19. Applicants submit that neither Noll nor Bruckner remedy the deficiencies of Carver with respect to these limitations as discussed above.

Applicants further submit that there is no motivation or suggestion to combine or modify the cited references. The Examiner states on page 19, last paragraph, to page 20, first partial paragraph of the final Office Action:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerba to include network operations center (NOC) or local processor collects information about viewer transactions for commerce purposes as taught by Noll for the benefit of targeting advertising and e-commerce material to the user and for determining account balances and transactional information. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include the central system processor is further operative to add interactive advertising content to non-interactive advertising content for a period of time defined by at least one local merchant offer; wherein the at least one central system processor is further operative to route the request data to the at least one local merchant using at least one advertisement identifier as taught by Bruckner in order to manage interactive content

that may or may not be known in advance and to be able to sell advertising space to the highest bidder as disclosed by Bruckner.

Applicants first note that the Examiner was most likely referring to Carver and not Gerba. Next, Applicants respectfully submit that this is a conclusory statement of the sort rejected by both the Federal Circuit and the U.S. Supreme Court. See KSR v. Teleflex, No. 13-1450, slip. op. at 14 (U.S., Apr. 30, 2007), quoting In re Kahn, 441 F. 3d 977, 988 (Fed. Cir. 2006) (“[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). There has been no showing in the present §103(a) rejection of the claims of objective evidence of record that would motivate one skilled in the art to combine Carver, Noll, and Bruckner to produce the particular limitations in question.

For at least these reasons, Applicants assert that the cited references fail to render claim 41 unpatentable. Accordingly, Applicants respectfully request withdrawal of the §103(a) rejection.

With regard to the §103(a) rejection of claims 46 and 48 over Tomsen in view of Noll, and further in view of Bruckner, Applicants respectfully submit that the combined references fail to teach or suggest all the limitations of claims 46 and 48, as amended. The Examiner concedes that “Tomsen is silent on the central system controller is capable of collecting information about viewer transactions for commerce purposes and does not explicitly disclose that the one central system controller a period of time defined by the at least one local merchant offer adds interactive content to non-interactive advertising content” and “Tomsen is silent on collecting information about the transaction for commerce purposes.” See Final Office Action, pages 21-22, and 24. Applicants submit that neither Noll nor Bruckner remedy the deficiencies of Tomsen with respect to these limitations as discussed above.

Applicants further submit that there is no motivation or suggestion to combine or modify the cited references. The Examiner states on page 22, last paragraph, to page 23, first partial paragraph; and page 25, last paragraph, to page 26, first partial paragraph of the final Office Action:

[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gerba to include network operations center (NOC) or local processor collects information about viewer transactions for commerce purposes as taught by Noll for the benefit of targeting advertising and e-commerce



material to the user and for determining account balances and transactional information as disclosed by Noll. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination to include a period of time defined by at least one local merchant offer as taught by Bruckner in order to manage interactive content that may or may not be known in advance and to be able to sell advertising space to the highest bidder and as disclosed by Bruckner.

Applicants first note that the Examiner was most likely referring to Tomsen and not Gerba. Next, Applicants respectfully submit that this is a conclusory statement of the sort rejected by both the Federal Circuit and the U.S. Supreme Court. See KSR v. Teleflex, No. 13-1450, slip. op. at 14 (U.S., Apr. 30, 2007), quoting In re Kahn, 441 F. 3d 977, 988 (Fed. Cir. 2006) (“[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). There has been no showing in the present §103(a) rejection of the claims of objective evidence of record that would motivate one skilled in the art to combine Tomsen, Noll, and Bruckner to produce the particular limitations in question.

For at least these reasons, Applicants assert that the cited references fail to render claims 46 and 48 unpatentable. Accordingly, Applicants respectfully request withdrawal of the §103(a) rejection.

With regard to the §103(a) rejections of the remaining dependent claims as being unpatentable over the references distinguished above in view of multiple secondary references, Applicants assert that the multiple secondary references fail to remedy the deficiencies of the references distinguished above. Thus, remaining dependent claims are patentable at least by virtue of their dependency from the various independent claims and also recite patentable subject matter in their own right. Accordingly, Applicants therefore respectfully request withdrawal of the §103(a) rejections.

In view of the above, Applicants believe that the pending claims are in condition for allowance, and respectfully request withdrawal of the §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis". The signature is fluid and cursive, with the first name "William" being more prominent and the last name "Lewis" following in a similar style.

Date: January 18, 2008

William E. Lewis  
Attorney for Applicant(s)  
Reg. No. 39,274  
Ryan, Mason & Lewis, LLP  
90 Forest Avenue  
Locust Valley, NY 11560  
(516) 759-2946